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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,258	11/03/2003	Robert J. Simmons	J-BSIM.1006	3704
56703 7590 12/29/2006 ROBERT D. VARITZ, P.C. 4915 SE 33RD PLACE PORTLAND, OR 97202			EXAMINER LAUX, JESSICA L	
			ART UNIT	PAPER NUMBER
			3635	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/700,258	SIMMONS, ROBERT J.	
	Examiner	Art Unit	
	Jessica Laux	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because:

The drawings are redundant with an over abundance of reference characters making the drawing figures unclear and messy.

Figure 1 is objected to because it shows all of the features in two dimensions which is inconsistent with the specification and understanding of the invention. In order to overcome this objection the drawings must show the objects of figure one in the proper dimension with the proper detail as described in the specification. (i.e. – reference characters 13a and 13b are described as spanner portions, however the figure shows them as a line of a two dimensional plane). All of the described and claimed features (i.e. the through chase, spanner portions, etc.) must be shown in the drawings in a clear, concise and accurate manner.

Figures 1-4 have not been described in the specification or drawings in such a way as to enable one skilled in the art to understand the invention. Each figure shows a portion of the described features and reference characters, but the combination of all of the drawings does not provide a clear understanding of the invention as described and claimed.

The spanner portions have been depicted in a way that would enable one skilled in the art to make and understand the invention as claimed and described in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "spanner" is used in the claims, the accepted meaning is "a metal

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wrench.” The term is indefinite because the specification does not clearly redefine the term.

Claim 5 is objected to, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation “takes the form of an I-beam” and “takes the form of a channel”. This wording is objected to because it appears that the referred portions are originally of a different shape and then through some unidentified process become shaped like an I-beam or a channel, respectively. This is not supported by the specification. As best understood by the examiner the claims are being examined “where the end portions are in the form of an I-beam” and “where the spanner portion is in the form of a channel”.

Claim 6 is objected to, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation “end-portion I-beam”, which lacks antecedent basis in the claims. The claims recite a chase beam with end portions in the form of an I-beam, but do not recite an I-beam with end portions as implied by claim 6.

Claim 6 is further objected to because line 3 recites “flanged” which is indefinite. Examiner suggests changing to “flanges”.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation of a central through-passage or chase passage, which is three dimensional, therefore the limitation that the three dimensional chase passage lies in a plane, which is two dimensional is indefinite.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by A.G. Dean (2082792).

Regarding claim 1: Dean discloses an elongate structural chase beam (figure 2), capable of use in a building frame as a unit extending laterally between, and with opposite ends anchored to, a pair of upright columns, and further capable of accommodating the vertical passage of selected building infrastructure through, and generally within the vertical plane containing, the long axis of the beam, said beam comprising: spaced opposite end portions (figure 2, where the beam is a finite object having a first end and a second end), and an elongate spanner portion (elements 3, 4) extending between and joining operatively with said end portions, and including a central through-passage (figures 2 and 3, the space between the spanner portions 3 and 4), referred to as a chase passage, that lies generally in a plane containing the beam's long axis.

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Regarding claims 2-4: Dean discloses an elongate structural chase beam, capable of use in a building frame as a unit extending laterally between, and with opposite ends anchored to, a pair of upright columns, and further capable of accommodating the vertical passage of selected building infrastructure through, and generally within the vertical plane containing the long axis of, the beam, said beam comprising: a pair of longitudinally spaced end portions (figure 2, where the beam is a finite object having a first end and a second end) defining opposite ends of the beam, and a pair of elongate, laterally spaced and generally parallel spanner portions (elements 3 and 4) extending between and having opposite ends operatively joined to said end portions, the space between said spanner portions defining a vertically clear chase passage (figures 2 and 3, the space between the spanner portions 3 and 4) extending as a clear space through the beam generally in a plane containing the beam's long axis.

Further regarding claims 1 and 2: The phrases "adapted for assembly in a building frame as a unit extending laterally between, and with opposite ends anchored to, a pair of upright columns" and "further adapted to accommodate the vertical passage of selected building infrastructure through, and generally within the vertical plane containing the long axis of, the beam" are recitations of intended use, which do not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus that satisfies the claimed limitations.

Regarding claims 3 and 4: The chase beam of claim 2 above, wherein at least one of or each of said end portions is formed with an overload fuse.

It should be noted that claims 3 and 4 are considered to be product-by-process claims. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

Regarding claim 5: The chase beam of claim 2, wherein each said end portion takes the form of an I-beam (as seen in figures 2 and 3), and each said spanner portion takes the form of a channel (as seen in figures 2 and 3, where the outwardly facing portions of elements 3 and 4 are channels).

Regarding claim 6: The chase beam of claim 5, wherein each end-portion I-beam has spaced flanges (6) with spaced, opposite-side pairs of outwardly facing lateral edges (generally at 1 and 2 of figure 3), said spanner-portion channels each includes a central web (generally at 3 and 4 of figure 3) and a pair of spaced flanges (6 of the spanner portion as seen in figure 3) extending from one side of said central web, and said spanner portions and each end portion are joined in a manner whereby said central webs are anchored to the lateral edges of different ones of associated, opposite-side pairs of said outwardly facing lateral edges, with the flanges in the spanner-portion channels extending outwardly away from the attached end portion (figure 3).

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Conclusion

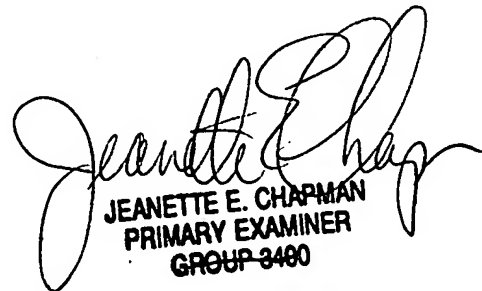
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

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12/18/2006


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